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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT C. CHANG, PING LI,  
and FARSHID SABET-SHARGHI

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Appeal 2008-2154  
Application 10/092,049  
Technology Center 2100

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Decided: December 16, 2008

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Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III,  
and CAROLYN D. THOMAS, *Administrative Patent Judges*.  
COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3, 5-8, 11-13, and 17-24. Claims 2, 4, 9, 10 and 14-16 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

## THE INVENTION

The disclosed invention relates generally to mass digital data storage systems. More particularly, the present invention relates to systems and methods for enabling a key which substantially controls access to the contents of a memory card to be stored separately from the memory card. (Spec. p. 1, ll. 5-8).

Independent claim 1 is illustrative:

1. A method for accessing encrypted information stored in a flash memory storage device, by operating a host system in communication with a reader, the reader including a memory storing a key according to which the information stored in the flash memory storage device is encrypted, the method comprising:

inserting the flash memory storage device into the reader;

forwarding an access code from the host system to the reader;

responsive to the access code being valid for the reader, obtaining the key from the reader; and

decrypting the information stored on the flash memory storage device using the key; and

forwarding the decrypted stored information to the host system.

## THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejection:

- |    |             |                 |  |
|----|-------------|-----------------|--|
| 1. | Tatebayashi | US 6,859,535 B1 | Feb. 22, 2005<br>(filed Oct. 15, 1999) |
| 2. | Jones       | US 5,623,637    | Apr. 22, 1997<br>(filed May 17, 1996)  |

## THE REJECTION

The Examiner rejected claims 1, 3, 5-8, 11-13 and 17-24 under 35 U.S.C. § 103 (a) as being unpatentable over Jones in view of Tatebayashi.

## DISPOSITIVE ISSUE

Did the Examiner err by failing to provide an articulated reasoning with sufficient rational underpinning to support the legal conclusion of obviousness?

## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Briefs to show error in the proffered *prima facie* case. Only those arguments actually made by

Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R.

§ 41.37(c)(1)(vii).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

## FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence:

### *Jones*

1. Jones is directed to a detachable PCMCIA memory card. (Abst. II, 1-3).

2. Jones teaches that the memory card includes circuitry that may be used to store public and private key values to encrypt and decrypt data stored on the card. (Col. 2, ll. 31-43).
3. Jones teaches that the circuitry of memory card 100 includes data storage (i.e., common memory array 150) and Smartcard I.C. 250 (Fig. 1).

*Tatebayashi*

4. Tatebayashi is directed to a digital content protection system. (col. 1, ll. 13-15).
5. Tatebayashi teaches an embodiment in which a memory card is placed in the headphone stereo that is a memory card reader. (Col. 8, ll. 35-38 and Fig. 3).

ANALYSIS

We note that the Examiner relied on Tatebayashi to cure the deficiencies of the primary Jones reference. More particularly, Tatebayashi is relied upon to teach a reader that is separate and separable from the flash memory storage device. (Ans. 4-5) The memory card 100 of Jones contains a memory array 150, which is asserted by the Examiner to teach the claimed “flash memory storage device” of claim 1, and a smartcard integrated circuit 250, which is asserted by the Examiner to teach the claimed “reader” of claim 1 (Ans. 3, see also FF 1-3). The Examiner’s stated motivation for combining the teachings of Tatebayashi with Jones is to “authenticate the flash memory with the reader.” (Ans. 5).

In presenting a prima facie case of obviousness, the Examiner must provide some articulated, rational reason to support the legal conclusion of obviousness.

(“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*KSR* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Appellants contend that the Examiner’s motivation to combine the teachings of Jones and Tatebayashi is not proper. More specifically, Appellants contend that there is no need to authenticate the flash memory with the reader because the flash memory and the alleged reader (smartcard) are embodied into the same physical object. (App. Br. 7). We agree.

Because the above mentioned circuitry taught in Jones is self contained within the PCMCIA memory card, we find that there is no need for the smartcard to authenticate a different smartcard IC, or in other words, to “authenticate the flash memory with the reader.” Thus, we find the Examiner’s stated motivation to modify the teachings of Jones with Tatebayashi is not supported in the record.

The Supreme Court warned against the use of “hindsight bias” in determining obviousness.

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. *See Graham*, 383 U. S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”).  
*KSR* at 1742 (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (C.A.6 1964)).

As noted by the Appellants, there is no need for the smartcard integrated circuit 250 and the flash memory array 150 (as taught by Jones) to authenticate one another because they are enclosed within the same PCMCIA card 100. Thus, we find Appellants’ arguments to be persuasive and find that the Examiner has failed to provide an articulated reasoning with sufficient rational underpinning to support the legal conclusion of obviousness. We conclude that Appellants have met their burden of showing error in the Examiner’s prima facie case of obviousness. Accordingly, we reverse the Examiner’s rejection of claim 1 as being unpatentable under 35 U.S.C. § 103(a) over Jones and Tatebayashi.

We further note that independent claim 13 recites a flash memory reader coupled to the host system comprising an “interface for receiving a flash memory storage device.” Thus, the discussion above regarding claim 1 is also applicable to independent claim 13. Accordingly, we reverse the Examiner’s rejection of claim 13 for the reasons discussed *supra* regarding claim 1. Because we have reversed the Examiner’s rejection of each independent claim on appeal, we also reverse the Examiner’s rejection of each dependent claim on appeal.



### CONCLUSIONS OF LAW

Appellants have established that the Examiner erred by failing to provide an articulated reasoning with sufficient rational underpinning to support the legal conclusion of obviousness.

Based on the findings of facts and analysis above, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims 1, 3, 5-8, 11-13, and 17-24, as being unpatentable over Jones in view of Tatebayashi under 35 U.S.C. § 103(a).

### DECISION

The decision of the Examiner rejecting claims 1, 3, 5-8, 11-13, and 17-24 under 35 U.S.C. § 103(a) is reversed.

### REVERSED

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BRINKS HOFER GILSON & LIONE/SanDisk  
P.O. BOX 10395  
CHICAGO IL 60610